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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,711	12/31/2001	Royce D. Jordan JR.	010568	5824

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EXAMINER

HESS, DANIEL A

ART UNIT PAPER NUMBER

2876

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,711

Applicant(s)

JORDAN, ROYCE D.

Examiner

Daniel A Hess

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-18,22-36 and 38-48 is/are rejected.
- 7) ☒ Claim(s) 3,19-21 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. Receipt is acknowledged of amendment dated 7/23/2003, which has been placed in the file of record, and to which this action is a reply.
2. In response to the applicant's arguments, the examiner notes that various deficiencies of the Seiderman reference discussed by applicant are in reference to the claims as amended (e.g. wireless data network, external network). Since the Seiderman reference is now replaced with new arguments in light of amendment, these arguments are rendered moot.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 6, 7, 9-12, 14-18, 23, 24, 26-29, 31-36, 38, 40, 41, 43-46 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Ortiz (US PG Pub No. 2002/0077974

A1). Ortiz teaches a method of credit card ordering via a wireless device having all of the elements and means as recited in claims 1, 2, 4, 6, 7, 9-12, 14-18, 23, 24, 26-29, 31-36, 38, 40, 41, 43-46 and 48. For example, Ortiz teaches the following:

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Re claims 1, 4, 15, 17, 35, 38: Ortiz teaches (page 2, [0022]) that wireless credit card transactions are made possible. As figure 5 shows, a wireless gateway 80 is present in communication with a wireless, hand-held device (page 5, [0066]). This gateway is in communication with a server 82 that can be implemented within a wireless network (WLAN). Thus, the gateway is in communication with a wireless network (page 5, [0066]). See figure 9 and description (page 8, [0094] to [0097]). The card data is transferred from the handheld device to the server [0095], necessarily through the gateway. At step 206 (figure 9) a credit card validation reply message, following approval, is given; this must necessarily also go through the gateway. Information to identify the credit card is transferred from the wireless device through the gateway to the server in step 200.

Re claims 2, 18, 36: See abstract, lines 15-16: The transaction is stored in the server. The gateway can be integrated with the server [0066]. Hence, it can be said that the transaction record is stored with the gateway.

Re claims 6, 12, 23, 29, 40, 46: Some devices envisioned, including the PDA mentioned by Ortiz, convey info to the user by means of text messages to the user's screen.

Re claims 7, 24, 41: Receipt (confirmation) can be [0068] sent to the customer's email address.

Re claims 9-10, 26-27, 43-44: Inherent -- normally we would expect that credit card information would require, at a minimum, credit card number and an expiration date for the credit card, in order to be sufficient for validation.

Re claims 11, 28, 45: The card number (re claim 9 above) constitutes an identifier.

Re claims 14, 31, 32, 48: Pager use is clearly envisioned [0002].

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Re claim 16: The card 50 can be [0055] a standard card (magnetic stripe). This implies swiping in figure 4.

Re claims 33 and 34: These claims indicate the presence of an intermediary between the validation requesting device and the card validation provider, which Ortiz shows.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 5, 8, 13, 22, 25, 30, 39, 42 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ortiz.

Re claims 5, 22, 39: Although Ortiz fails to explicitly teach that the connection between the gateway and the server is the Internet, there is no particular reason why it should not be, for it is well-known in the art of networking that a network connection can be across any network including the Internet without impacting functionality, since networks are designed to be 'blind' to how data is routed. Hence the principle of equivalence applies. The motive to use the Internet is simply to permit the server to be located at a distance from the Gateway.

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Re claims 8, 25, 42: The different methods by which the text message is sent can be regarded as equivalent (in re Dillon) because one would expect different types of text messages to achieve the same thing namely getting the validation information across.

In In re Dillon, applicant claimed a composition comprising a hydrocarbon fuel and a sufficient amount of a tetra-orthoester of a specified formula to reduce the particulate emissions from the combustion of the fuel. The claims were rejected as obvious over a reference which taught hydrocarbon fuel compositions containing tri-orthoesters for dewatering fuels, in combination with a reference teaching the equivalence of tri-orthoesters and tetra-orthoesters as water scavengers in hydraulic (nonhydrocarbon) fluids. The Board affirmed the rejection finding “there was a reasonable expectation’ that the tri- and tetra-orthoester fuel compositions would have similar properties based on close structural and chemical similarity’ between the tri- and tetra-orthoesters and the fact that both the prior art and Dillon use these compounds as fuel additives’.” 919 F.2d at 692, 16 USPQ2d at 1900. The court held “it is not necessary in order to establish a prima facie case of obviousness . . . that there be a suggestion or expectation from the prior art that the claimed [invention] will have the same or a similar utility as one newly discovered by applicant,” and concluded that here a prima facie case was established because “[t]he art provided the motivation to make the claimed compositions in the expectation that they would have similar properties.” 919 F.2d at 693, 16 USPQ2d at 1901 (emphasis in original).

Re claim 13, 30, 47: Confirmation is sent by email (see claim 7). It is common for users to be able to check email from their cell phone.

Allowable Subject Matter

8. Claims 3, 19, 20, 21 and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The examiner could not find within the prior art of record any teaching in which a database in the above gateway associates the wireless device with the credit card validation message.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

13. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DH

Daniel A Hess
Examiner
Art Unit 2876



KARL D. FRECH
PRIMARY EXAMINER